

REMARKS

Applicant has carefully considered the Examiner's Office Action and has amended the claims to define the invention in clearer form and to avoid the Examiner's objections.

Applicant has also amended the specification to provide for clarification and to respond to the Examiner's objections.

In considering the Examiner's comments with respect to the secondary piston 9, applicant notes that this piston is actually fixed to the housing 7 and is not axially movable. The expression secondary piston was selected because this secondary piston is similar to a conventional damping piston which has damping valves as clearly shown in Figure 1 of applicant's arrangement. This means that the element designated as secondary piston 9, and in which a bypass is provided, results in a damping effect through the bypass.

This arrangement provided by applicant is not present in the reference patent to Neumann (4,974,707).

Thus, in this reference patent to Neumann, the second bypass 153, noted by the Examiner, can be switched on or off through the valving element 123b. This is clearly described in the reference patent to Neumann in column 9, lines 25 to 35.

By actuating or energizing the exciter coil 126b in the reference patent to Neumann, the inner valving element 123b can be drawn against the spring force of spring 128b to an open position, so that the bypass 153 is opened and thereby switched off.

If, on the other hand, the coil 126b is not subjected to current, then spring 128b presses the inner valving element with its ring-shaped edge 151 against the oppositely-lying sealing surface, whereby the bypass 153 is closed. This signifies that the bypass 153 is either open or closed.

However, when the bypass 153 is opened, then this bypass in the reference patent to Neumann does not provide any damping

effect because this bypass has no damping valves. This is an important difference between applicant's invention and the reference patent to Neumann.

Unlike this reference patent to Neumann, applicant's invention provides that the secondary piston 9 has passive damping valves which apply a damping effect to the damping fluid flowing through the bypass.

Applicant has amended the base claim 5 with the recitation that the secondary piston 9 is provided with damping valves which result in a damping effect in the bypass in which the secondary piston 9 is located. This feature is clearly shown in Figure 1 of applicant's arrangement, and the damping valves were recited in the original claim 12. As a result, the addition to base claim 5 was previously considered by the Examiner and is therefore not a new issue.

It is submitted that applicant provides for a new and marked improvement over the prior art.

Since the claims in the application define clearly the differences between applicant's invention and the prior art, it is believed that the claims should be found allowable.

Applicant has carefully studied the additional reference cited by the Examiner for being of interest but not applied in the case. After detailed analysis of this additional reference, applicant has concluded that it is entirely unrelated to applicant's invention, and it does not anticipate the novel features of applicant's arrangement.

The Examiner's attention is respectfully directed to the decision of the court in the case of *In re Bisley* (94 U.S.P.Q. 80, 86), in which the court ruled that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not

necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

Furthermore, in the case of *ex parte* Chicago Rawhide Manufacturing Company (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

In the case of *United Merchants and Manufacturers Incorporated versus Ladd* (139 U.S.P.Q. 199), the District Court ruled that although from simplicity of device and with advantage of hindsight, one might off-handedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the references discloses or suggests the concept which is the crux of the invention.

Finally, in the case of *Menge and Drissen* (181 U.S.P.Q. 94), the Court ruled that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

In view of the amendments to the claims and the specification, and in view of the preceding remarks, it is respectfully requested that the claims in the application be allowed and the case be passed to issue.

Should the Examiner require or consider it advisable that the claims and/or specification be further amended or corrected in formal respects to place the application in condition for final allowance, then it is respectfully requested that such amendments be carried out by Examiner's Amendment, through a phone call to applicant's representative, and the case passed to issue.

Respectfully submitted,

By: Max Fogiel 8/15/05
Max Fogiel
44 Maple Court
Highland Park, NJ 08904
Phone: (732) 214-8892

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